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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/529,925 07/30/00 GEORGES E 641050.90013

HM12/1221

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EXAMINER

WILDER, C

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/529,925

Applicant(s)

GEORGES et al.

Examiner

CB Wilder

Group Art Unit

1655



☒ Responsive to communication(s) filed on Apr 26, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 6, 7, 15-27, 30, and 31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 6, 7, 15-27, 30, and 31 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, Applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 6, 7, 24-27, 30, 31, drawn to method of detecting Annexin based MDR and pharmaceutical composition.

Group II, claim(s) 15-23, drawn to method of identifying a compound.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I and II lack the same technical feature since they are distinct methods which differ in method objectives, method steps and reagents used.

A 371 case is considered to have unity of invention only wherein there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression "special technical feature" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. While the instant claims all involve the "Annexin-based MDR", it is clear from the following

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reference: (WO 86 04094 (BIOGEN) 17 July 1986 and Horseman et al. Gene. and Comp. Endocrinol. (1992) 85: 405-14) that "compounds effecting the Annexin-based MDR" does not define a contribution over the prior art.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and because the literature searches required for examination of the groups identified above are not coextensive, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: nucleic acid molecule, antibody, peptide and protein.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, Applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The claims are deemed to correspond to the species listed above in the following manner:

Claims 15-23, 26, 27, 30-31.

6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The different species are distinct because they are drawn to a nucleic acid molecule and peptide, antibody and protein. The different species differs in structural and biological properties. For example, the nucleic acid molecule is composed of nucleotides whereas the peptide, antibody and protein are drawn to amino acids. The different species are additionally distinct in that they can be used in different methodologies as well.

7. A telephone call was made to Jean Baker on November 28, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made. Ms. Baker request a written restriction be made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

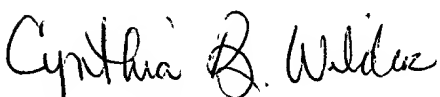
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amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

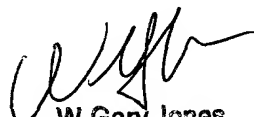
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cynthia Wilder whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152. The official fax phone number for the Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed the Group's receptionist whose telephone number is (703) 308-0196.


Cynthia B. Wilder, Ph.D.

December 17, 2000


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600
12/18/00